The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MAILED

Ex parte
JEROME MELVIN KLOSOWSKI,
CHARLES WAYNE SMITH
and DONNY LEON HAMILTON

JUL 2 2 2003

PAT. & T.M. OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. 09/410,162

ON BRIEF

Before KIMLIN, OWENS and LIEBERMAN, <u>Administrative Patent Judges</u>. LIEBERMAN, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 51, 54 and 55. Claims 52, 53 and 56 through 71 stand withdrawn from consideration pursuant to a requirement for restriction. These are all the

claims pending in this application.

THE INVENTION

The invention is directed to a method of preserving a material by impregnating the material with at least one hydrolyzable silane and curing the product obtained therefrom.

Additional limitations are described in the following illustrative claims.

THE CLAIMS

Claims 51, 54 and 55 are illustrative of appellants' invention and are reproduced below.

- 51. A method of preserving organic and inorganic materials, the method comprising:
- (I) Impregnating a material selected from
 - a. organic materials or
 - b. inorganic materials

with a hydrolyzable silane or a mixture of hydrolyzable silanes and thereafter, curing the product of (I).

- 54. A method as claimed in claim 51 wherein the hydrolyzable silane is an acetoxysilane.
- 55. A method as claimed in claim 54 wherein the acetoxysilane is methyltriacetoxysilane.

THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Pinchuk

5,736,251

Apr. 7, 1998

Leidheiser, H. et al., (Leidheiser) <u>Corrosion Behavior of Steel Pre-treated with Silanes</u>, Corrosion, (June 1987 43(6) pp. 382-387.

THE REJECTIONS

Claims 51, 54 and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pinchuk.

Claim 51, 54 and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Leidheiser.

OPINION

We have carefully considered all of the arguments advanced by the appellants and the examiner and agree with the examiner that the rejection of the claims under §103(a) over Pinchuk is well founded. Accordingly, we affirm the rejection for the reasons discussed herein. We will not however sustain the rejection over Leidheiser.

As an initial matter, it is the appellants' position that, "[t]he claims may be grouped together for the purposes of this appeal." See Brief, page 2. Accordingly, we select claim 51 as representative of the claimed subject matter and substantially limit our consideration thereto. See 37 CFR $\S1.192(c)(7)$ (2000).

The Rejection under § 103(a)

It is the appellants' position that, "[n]owhere in the disclosure of the '251 patent do the patentees suggest or contemplate impregnating the articles of their invention." See Brief, page 3. We disagree.

Pinchuk is directed to a highly crosslinked silane treatment for reducing the coefficient of friction of a surface. See column 1, lines 10-16 and column 2, lines 43-47. The surface being treated is located on a shaped elastomeric article. See column 3, lines 56-67. We find that the silanes may be applied to the surface by any suitable application means. See column 3, lines 18-23. We find that the silanes are crosslinkable and the invention includes the presence of a crosslinking agent. See column 4, lines 16-33 and 66-67. We further find that the silanes form a crosslinked silicone surface modification as well as, "a crosslinked interpenetrating network within the substrate." See column 5, lines 1-8. Significantly, we find that Example 7 is directed to a urethral valve catheter equipped with a silicon balloon and vapor phase treated with methyl triacetoxy silane which is the preferred silane of claim 55. The balloon portion was cured at 150° C. Pinchuk states that, "[w]hen the balloon portion was cut open, micro nodules of silane surface treatment were observed on the interior surface of the balloon which was not directly contacted with the silane vapors. From this observation, it was concluded that the silane treatment of the invention penetrated the bulk of the balloon catheter substrate and was not only a surface coating." See Example 7, column 11, lines 8-21. Emphasis ours.

Impregnate is defined as "2 a : to cause to be filled, imbued, mixed, furnished, saturated (as with particles of another substance). . . . b (1) to mix with :

INTERPENETRATE."1

Inasmuch as the silane treatment penetrated throughout the elastomer and mixed with the elastomer, we conclude that the elastomeric material was "impregnated" as required by the claimed subject matter. We further conclude that, inasmuch as the silane utilized by Pinchuk in Example 7 is the preferred silane of claim 55, the organic material would be inherently "preserved" as required by the claimed subject matter. Stated otherwise, "preserving" the material would be an inherent property inasmuch as the method and material utilized are the same.

Based upon the above findings and analysis, we conclude that the examiner has established a <u>prima facie</u> case of obviousness with respect to the claimed subject matter, this being the sole issue before us for consideration with respect to the rejection over Pinchuk.

As for the second rejection, Leidheiser teaches the protection of an inorganic material, i.e., steel, with polymerized methyl triacetoxy silane. See Answer, page 4. There is no suggestion or teaching however, in Leidheiser that the polymerized triacetoxy silane impregnates the steel as required by the claimed subject matter. In support of her position, the examiner cites In re Marra 329 F.2d 970, 972, 141 USPQ 221, 223 (CCPA 1964) stating that, "the art does not recognize any distinction between coating and impregnating." Id.

¹ Webster's Third New International Dictionary, p. 1136 (G. & C. Merriam Co., 1971). Copy attached.

The pertinent portion of the decision reads as follows;

We have difficulty accepting the distinction urged by appellants that 'coating' differs from 'impregnating' in this case. It would appear that a porous material like paper would be impregnated to some extent by an aqueous composition applied by 'various coating techniques' as Keim et al. suggests, whether the composition is called 'coating' or 'impregnating.' It seems doubtful that a clearly defined interface between the coating and the paper would result.

On the facts before us in this case, we have difficulty in accepting coating and impregnation of steel as being art recognized equivalents, steel being a non-porous material. We conclude that a non-porous material, such as steel, would be coated but not impregnated, by applying methyl triacetoxy silane. Any reaction with the steel would at most be limited to a surface reaction between the silane and the substrate in the absence of impregnation. Accordingly, the rejection of the claims over Leidheiser is not sustainable.

DECISION

The rejection of claims 51, 54 and 55 is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Appeal No. 2002-0223 Application No. 09/410,162

DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994

importuning a male person in the park) ~ vl 1: to beg, urge, or solicit persistently or troublesomely 2: to make immoral or lewd advances toward another (fined for importuning in a public convenience—T.A.Cullen) syn see bed im.portuning in portunite. It. MF Importunite, fir. L Importunitat., Importunitats, Importuni

the good-natured tolerance of the public—Roger Fryy (succeed in deceiving, and imposing upon, others—George Meredith)
imposed load n: the part of the total load sustained by a structure or member thereof that is applied to it after erection—compare DEAD LOAD
imposer (>20(1) n: one that imposes; esp: STONEMAN 1
imposing adj 1 archaic: insistent and exacting 2 archaic: DECEPTIVE, TREACHENOUS 3: impressive because of size, scope, bearing, dignity, or grandeur: COMMANDING (an ~ building) (an ~ appearance) Syn see GRAND
im-pos-ing-19 adv: in an imposing manner; esp: impressiveLy im-pos-ing-iness n-is: the quality or state of being imposing imposing stone or imposing table or imposing surface n: a slab of stone or metal on which matter to be printed is imposed.

im-pos-ing-yadv: in an imposing manner; spr: impressiveLy im-pos-ing-ness n-es: the quality or state of being imposing imposing stone or imposing table or imposing surface n: a slab of stone or metal on which matter to be printed is imposed im-po-si-tion \, imposition, fr. LL imposition, fr. MF & LL; MF Imposition, fr. LL imposition, imposition fr. L impositios (past part of imponere) + -lon, -lo-ion] 1; the act of imposing: as a: the laying on of the hands as a religious ceremony (as in ordination or confirmation) b: a putting, placing, or laying on (the ~ of color on the clear wood) (the ~ of a second layer on the first) c: an applying by compelling means (the ~ of rigid censorship) (the ~ of a second layer on the first) c: an applying or assessment (as of a tax or a fine) (the ~ of extra charges for extra services) (the ~ of a high tariff) e: the arranging on an imposing stone of matter to be printed 2: something imposed: as a: Levy, tax (an ~ of 5000 francs on a coat) b obs: COMMAND, CHARGE c: an excessive, unwarranted, or uncalled-for requirement or burden (severe ~s on her children—John Dollard) d: an exercise imposed as punishment on a student (as at an English public school) 3: the act of imposing upon another or the condition of being imposed upon: DECEPTION (know that their tricks are ~ www.lwowls) 4: the order of arrangement of imposed pages or other matter (the standard ~s are simple multiples of 16 pages—Plan for a Good Book)

im-possibilist (")im, sm+\ n [L impossibilis + E-ism]

1: a political purpose or plan felt: to be impossible of achievement 2: the advocacy of an impossibilist, fr. MF & Limpossibility (")im, sm+\ n [L impossibility fr. and the prossibility (")im, sm+\ n [ME impossibility fr. and the prossibility of the political setup for a nonex many 2 obs: 1 NABLITT 3: something impossible of attainment (a child who always goes after impossibilities)

1 im-possibility (")im, sm+\ n [ME impossibility of being dealt with by reasonable or acceptable means (his cool cheek, his frightful temper

pier, or wall) from which an arch springs—see ARCH illustration imposterous adj. obs: IMPOSTROUS im-pos-tor or im-pos-ter \am'p3sto(r)\ n -s [MF & LL; MF imposteur, fr. LL impostor, fr. L impostus, impositus (past part. of imponere to put upon, impose, deceive, cheat) + -or — more at impose; one that practices imposture: one that assumes an identity, character, or title not his own for the purpose of deception: PRETENDER, FRAUD, HUMBUG im-pos-trous \(\frac{1}{2}\) mipdstrays, am'p-\(\frac{1}{2}\) of; relating to, or being an imposture: DECETTFUL, FRAUDULENT impostumate or imposthumate vb-Ep-\(\frac{1}{2}\)-\(\frac{

being an imposture : DECETTUL, FRAUDULENT impostumate or imposthumate or beto-tholy-self-impostume + aite 1, obs : to affect with an impostume impostume | 1, obs : to affect with an impostume | 10 affect with a postume | 10 affect | 10 affe

but a coat and a wig and a mask smiling below it — nothing but a great simulacrum —W.M.Thackeray) (something whose essence was not there at all, a stiff lifeless simulacrum —J.C. Powys)
2imposture vi. obs: to practice imposture — vi 1 obs: to show to be an imposture 2 obs: DECEIVE Imposture vi. obs: to practice imposture — vi 1 obs: to show to be an imposture 2 obs: DECEIVE Imposture vi. obs: to show to be an imposture 2 obs: DECEIVE Impostable — more at posture 2 obs: DECEIVE Impostable — more at posture vi. obs: timpostable (")im+\ adj [LL impostablis, fr. L In-\ \frac{1}{1}\ \text{in-}\ \text{the distable of concealments and \sigma's can be exaggerated —John Cheever) imposture vi. obs: \(\frac{1}{1}\) impostable — more at postablis, fr. L In-\ \frac{1}{1}\ \text{in-}\ \text{the distable of control}\ \text{im-postable of vimpole-obs}\ \text{ompostable im-postence}\ \text{im-postable of vimpole-obs}\ \text{ompostable of vimpole-obs}\ \text{of im-postence}\ \text{im-postence}\ \text{om-postence}\ \text{om-postence}\ \text{of self-control}\ \text{if. im-postent: as a: lack of strength: Weakness, Febleness (the very \simpostable of the government, the impossibility of doing anything —Upton Sinclairy: Helpleness (reduce them to intellectual \simpostable —H.J.Laski) \(\text{a small force} \cdots \cdots \text{reduced to} \simpostable a loculate — M.J.Laski) \(\text{c} \) (1): a physical or psychological abnormal state usu. of a male characterized by inability to copulate — compare sterring obs: lack of self-crestraint or self-control \(\text{im-postent}\) - only 2: Sterring — not used technically 2 [L impotent]\(\text{of als kof self-crestraint or self-control \(\text{im-postent}\) - in 2 in oto potent: lacking in power, strength, or vigor: deficient in capacity: weak, Powerless (he liked to be bad and see them all \simpostable \text{of self-control}\) impotent. \(\text{im-postent}\) - in an impotent \(\text{im-postent}\) - in zone that is impotent: was of males 2 [L impotent, impotens]\(\text{ obs}\) 3 ste

im-po-tent-ly adv: in an important MELPLESSLY
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cxhaust the strength, richness, or fertility of; make sterile (worked the land year after year until it was ~ed) syn see DEPLETB impoverished adl, of a launa or flora; represented by few species or individuals; SCANTY impov-er-ish-ment | manty n =s [AF empoverishing or the state of being impoverished (soil ~) (spiritual ~) impower obs var of betwower improvement impracticability ((im, am+) n !; the quality or state of obeing impracticable; 2; something impracticable of being impracticable (impracticability ((im, am+) adl [lin-practicable] 1 a; not practicable); (incapable of being performed or accomplished by the means employed or at command: interstile (economically ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which will provide a security ~ 10 maintain an air force which will provide absolute security ~ 10 maintain an air force which

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ito, fr. LL Impraegnatus + L -lors, -lo -lon] 1 : the ac
impregnating or the state of being impregnated: as a
causing to conceive : FECUNDATION, FERTILIZATION b
cusing to conceive : SECUNDATION, FERTILIZATION b
cusing to conceive : SECUNDATION, FERTILIZATION b
cusing to conceive : SECUNDATION C 2: something
FUSION, SATURATION C : INDOCTRINATION C 2: something

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